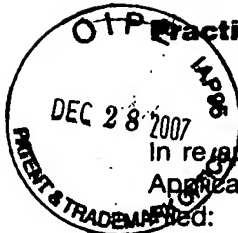


12-31-07

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Practitioner's Docket No. 20850.150

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re/application of: Carlos A. Khantzis
Application No.: 10/800,233 Group No.: 3728
Filed: 03/11/2004 Examiner: John Ted Kavanaugh
For: Reexamination control No.:
SHOE SOLE TO IMPROVE WALKING, SENSORY RESPONSE OF THE TOES, AND HELP
DEVELOP LEG MUSCLES

Mail Stop Appeal Brief—Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLICATION OR EX PARTE REEXAMINATION—
37 C.F.R. § 41.37)

NOTE: The phrase "the date on which" an "appeal was taken" in 35 U.S.C. 154(b)(1)(A)(ii) (which provides an adjustment of patent term if there is a delay on the part of the Office to respond within 4 months after an "appeal was taken.") means the date on which an appeal brief under § 1.192 (and not a notice of appeal) was filed. Compliance with § 41.37 requires that: 1. the appeal brief fee (§ 41.20(b)(2)) be paid (§ 41.37(a)(2)); and 2. the appeal brief complies with §§ 41.73(c)(i)-(x). See Notice of September 18, 2000, 65 Fed. Reg. 56366, 56385-56387 (Comment 38).

1. Transmitted herewith is the APPEAL BRIEF in this application, with respect to the Notice of Appeal filed on October 29, 2007

NOTE: Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31. 37 CFR 41.(a)(1). The brief is no longer required in triplicate. The former alternative time for filing a brief (within the time allowed for reply to the action from which the appeal was taken)

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*
*(When using Express Mail, the Express Mail label number is mandatory;
Express Mail certification is optional.)*

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37 C.F.R. § 1.8(a)

37 C.F.R. § 1.10 *

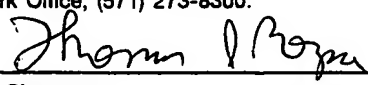
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Signature

Date: 12-28-2007

Thomas I. Rozsa

(type or print name of person certifying)

* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

has been removed. Appellant must file within two months from the notice of appeal. See Notice of August 12, 2004, 69 FR 49960, 49962.

2. STATUS OF APPLICANT

This application is on behalf of

- ☐ other than a small entity.
☒ a small entity.

A statement:

- ☐ is attached.
☒ was already filed.

3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 C.F.R. § 41.20(b)(2), the fee for filing the Appeal Brief is:

- ☒ small entity \$ 255.00
☐ other than a small entity \$500.00

Appeal Brief fee due \$ 255.00

4. EXTENSION OF TERM

NOTE: 37 C.F.R. § 1.704(b) ". . .an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph."

NOTE: The time periods set forth in 37 C.F.R. § 1.192(a) are subject to the provision of § 1.136 for patent applications. 37 C.F.R. § 1.191(d). See also Notice of November 5, 1985 (1060 O.G. 27).

NOTE: As the two-month period set in § 1.192(a) for filing an appeal brief is not subject to the six-month maximum period specified in 35 U.S.C. § 133, the period for filing an appeal brief may be extended up to seven months. 62 Fed. Reg. 53,131, at 53,156; 1203 O.G. 63, at 84 (Oct. 10, 1997).

- ☐ The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136 apply.

WARNING: The provisions of 37 CFR § 1.136 do not apply in an ex parte reexamination. Any requests for extension must be made pursuant to 37 CFR 1.550(c).

(complete (a) or (b), as applicable)

- (a) ☐ Applicant petitions for an extension of time under 37 C.F.R. § 1.136 (fees: 37 C.F.R. § 1.17(a)(1)-(5)) for the total number of months checked below:

Extension (months)	Fee for other than small entity	Fee for small entity
<input type="checkbox"/> one month	\$ 120.00	\$ 60.00
<input type="checkbox"/> two months	\$ 450.00	\$ 225.00
<input type="checkbox"/> three months	\$ 1,020.00	\$ 510.00
<input type="checkbox"/> four months	\$ 1,590.00	\$ 795.00
<input type="checkbox"/> five months	\$ 2,160.00	\$1,080.00

Fee: \$ _____

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

- ☐ An extension for _____ months has already been secured, and the fee paid therefor of \$ _____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ _____

or

- (b) ☒ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

5. TOTAL FEE DUE

The total fee due is:

Appeal brief fee \$ 255.00

Extension fee (if any) \$ _____

TOTAL FEE DUE \$ 255.00

6. FEE PAYMENT

- ☒ Attached is a ☒ check ☐ money order in the amount of \$ 255.00
- ☐ Authorization is hereby made to charge the amount of \$ _____
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NOTE: If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to change the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, 1065 O.G. 31-33.

- ☒ If any additional extension and/or fee is required,

AND/OR

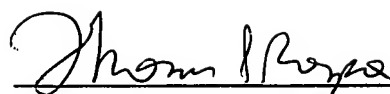
- ☒ If any additional fee for claims is required, charge:
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WARNING: Credit card information should not be included on this form as it may become public.

Date: Dec 28, 2007

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Customer No.: 021907



SIGNATURE OF PRACTITIONER

Thomas I. Rozsa

(type or print name of practitioner)

ROZSA LAW GROUP LC

18757 Burbank Boulevard, Suite 220

P.O. Address

Tarzana, California 91356-3346

CERTIFICATION OF SERVICE

NOTE: Papers filed with the Board, if not previously served, must be served simultaneously on every opposing party except as the Board expressly directs. If a party is represented by counsel, service must be on counsel. Service must be by EXPRESS MAIL® or by means at least as fast and reliable as EXPRESS MAIL®. Electronic service is not permitted without Board authorization. (37 CFR 41.106(e))

The signature below certifies that:

☐ A copy of this paper has been served on all opposing parties via ☐ Express Mail ☐
Other (specify) _____ on _____ (date) addressed as follows:

(1) _____ (2) _____
Name _____ Name _____

Address _____ Address _____

NOTE: A certificate made by a person other than a registered patent practitioner must be in the form of an affidavit. (37 CFR 41.106(f)(4))

I hereby declare that all statement made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

 12/28/07

Signature of Practitioner

Signature of person making declaration

Thomas I. Rozsa

(type of print name of practitioner)

(type or print name of person making
declaration)

ROZSA LAW GROUP LC

18757 Burbank Blvd., No. 220

Address

Address)

Tarzana, CA 91356-3346

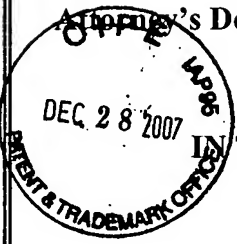
Reg. No.: 29,210

Tel. No.: (818) 783-0990

Customer No.: 021907

ROZSA LAW GROUP LC
ATTORNEYS AT LAW
18757 BURBANK BOULEVARD, SUITE 220
TARZANA, CALIFORNIA 91356-3346
TELEPHONE (818) 783-0990

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Applicant's Docket No.: 20850.150

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:

Carlos A. Khantzis

Serial No.: 10/800,233

Filing Date: 03/11/2004

For the Invention of:

**SHOE SOLE TO IMPROVE WALKING,
SENSORY RESPONSE OF THE TOES, AND
HELP DEVELOP LEG MUSCLES**

Group Art Unit No.: 3728

Examiner: John Ted Kavanaugh

Telephone: (571) 272-4556

Mail Stop Appeal Brief – Patents

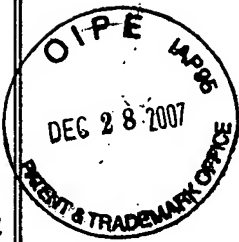
Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

APPELLANT'S BRIEF (37 C.F.R. § 41.37)

This brief is in furtherance of the Notice of Appeal filed in this case on October 29, 2007. The fees required under 37 C.F.R. § 1.17(f) and any required petition for extension of time for filing this brief and fees therefor are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.



CERTIFICATE OF MAILING (37 C.F.R. § 1.8(a))

I hereby certify that this paper (along with any paper referred to as being transmitted therewith) is being deposited with the United States Postal Service on the date shown below with sufficient postage as Express Mail No. EM 187727199 US in an envelope addressed to Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Date: December 28, 2007

Thomas I. Rozsa

Thomas I. Rozsa
Registration No. 29,210

ROZSA LAW GROUP LC
ATTORNEYS AT LAW
18757 BURBANK BOULEVARD, SUITE 220
TARZANA, CALIFORNIA 91356-3346
TELEPHONE (818) 783-0990



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ROZSA LAW GROUP LC
ATTORNEYS AT LAW
18757 BURBANK BOULEVARD, SUITE 220
TARZANA, CALIFORNIA 91356-3346
TELEPHONE (818) 783-0990

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I. REAL PARTY IN INTEREST - 37 § 41.37(c)(1)(I)

The Real Party In Interest is the Inventor:

Carlos A. Khantzis

4737 Galendo Street

Woodland Hills, California 91364

II. RELATED APPEALS AND INTERFERENCES

- 37 C.F.R. § 41.37(c)(1)(ii)

There are no related appeals or interferences.

III. STATUS OF CLAIMS - 37 C.F.R. § 41.37(c)(1)(iii)

The above identified Patent Application Serial No. 10/800,233 filed on March 11, 2004 (hereafter the "Appellants' Application" or "'233 Application") has a remaining total of twenty eight (28) claims of invention of which all twenty eight (28) are still pending in the case. The status of the claims of the '233 Application is as follows:

Claims cancelled: Claims 15-31, 46-62

Claims pending: Claims 1-14 and 32-45;

Claims allowed: none;

Claims rejected: Claims 1-14 and 32-45; and

Claims on appeal: Claims 1-14 and 32-45.

IV. STATUS OF AMENDMENTS - 37 C.F.R. § 41.37(c)(1)(iv)

The Appellants filed an Amendment after a second non-final Office Action which was mailed to the Patent Office on June 12, 2007. The Examiner issued a final rejection mailed on July 3, 2007. There are no amendments filed since the final rejection by the Patent Examiner.

V. SUMMARY OF CLAIMED SUBJECT MATTER -
37 C.F.R. § 41.37(c)(1)(v)

The original '233 Application was filed on March 11, 2004 and was assigned Application Serial No. 10/800,233.

The original '233 Application had sixty-two (62) claims of invention. In a first Office Action which was a restriction requirement mailed from the Patent Office on April 24, 2006, the Examiner stated that there were four patentably distinct species. Species I related to Claims 1-14 and 32-45 drawn to a shoe with a gel pad underneath the front area beneath the toes; Species II related to Claims 15-17 and 46-48 drawn to a shoe with a pad located under the toes in a cavity located in the insole; Species III related to Claims 18-20 and 49-51 drawn to a shoe with a pad located underneath the toes and a cavity in both the insole and midsole; Species IV related to Claims 21-33 and 52-62 drawn to a shoe with a pad located in a cavity in the front of the shoe. Appellant filed a Response to Restriction Requirement on May 22, 2006 electing Species I Claims 1-14 and 32-45 for further examination. The election was made without traverse.

After the Response to Restriction Requirement, the case had 28 claims of invention remaining including six independent claims.

Independent Claim 1 related to a shoe sole including an outsole, a midsole, an insole and having a front area over which the toes of a foot rest when the shoe is worn, with the improvement comprising: (a) a non-leaking deformable gel formed within the front area of the sole and aligned with the insole so that the gel is located beneath the toes of the foot when the shoe is worn, so that all five toes rest on the gel and the base of the big toe right below the 1st metatarso-phalangeal joint also rests on the gel; (b) whereby the non-leaking deformable gel permits the toes to curl, flex, bend or grasp downward when a wearer of the shoe is walking.

Dependent Claims 2 and 3 further limited the material.

Independent Claim 4 was similar to Claim 1 but dealt with a deformable padding

1 formed within the front area of the sole and aligned with the insole so that the deformable
2 padding is located beneath the toes of the foot when the shoe is worn, so that all five toes rest
3 on the deformable padding and the base of the big toe rests right below the 1st metatarso-
4 phalangeal joint and also rests on the deformable padding.

5 Dependent Claims 5-9 further limited Independent Claim 4.

6 Independent Claim 10 was similar to the first two independent claims but dealt with a
7 flexible and deformable material formed within the front area of the foot wearing item and
8 aligned with the insole so that the flexible material is located beneath the toes of the foot
9 when the foot wearing item is worn so that all five toes rest on the flexible material and the
10 base of the big toe right below the 1st metatarso-phalangeal joint also rests on the flexible
11 material.

12 Dependent Claims 11-14 further limited this.

13 Independent Claim 32 was similar to the other independent claims but dealt with a
14 non-leaking deformable gel formed within the front area of the sole and aligned with the
15 insole so that the gel is located beneath the toes of the foot when the shoe is worn, so that all
16 five toes rest on the gel.

17 Dependent Claims 33 and 34 further limited Independent Claim 32.

18 Independent Claim 35 was similar to Independent Claim 32 but instead dealt with a
19 deformable padding rather than a non-leaking deformable gel.

20 Dependent Claims 36-40 further limited Independent Claim 35.

21 Independent Claim 41 substituted a flexible and deformable material instead of the
22 deformable gel of Claim 35 or the non-leaking deformable gel of Claim 32.

23 Dependent Claims 42-45 further limited Independent Claim 41.

24 The Patent Examiner issued a first rejection on August 11, 2006 wherein the Examiner
25 rejected Claims 11, 12, 42 and 43 under 35 U.S.C. § 112 and rejected Claims 1, 3-7, 9-14, 32,
26 34-38, and 40-45 under 35 U.S.C. § 103(a) as being unpatentable under United States Patent
27 5,155,927 issued to Bates in view of United States Patent 6,922,918 issued to Eisler. The
28 Examiner rejected Claims 2, 8, 33 and 39 as being obvious under 35 U.S.C. § 103(a) in view

1 of the above two references and in view of Grisoni et al., US2005/0039349.

2 The Appellant timely filed an amendment on January 3, 2007 responsive to the Office
3 Action presenting arguments for allowance. The Appellant made minor corrections to
4 Dependent Claims 11 and 12 by changing the word "comprising" to "consisting of" and also
5 corrected Dependent Claims 42 and 43 to change the word "comprising" to "consisting of" to
6 overcome the rejection based on 35 U.S.C. § 112. All of the other claims remained
7 unchanged.

8 The Appellant presented extensive arguments as to why the present invention was not
9 obvious in view of the references cited by the Examiner.

10 Based upon the arguments presented by the Appellant in their amendment timely
11 mailed to the Patent Office after an extension of time was requested which was mailed on
12 January 3, 2007, the Examiner issued a second non-final Office Action on January 30, 2007
13 citing entirely new references. The Examiner now rejected Claims 4, 6, 7, 10, 11, 12, 35, 37,
14 38, 41, 42 and 43 under 35 U.S.C. § 102(b) as being anticipated by United States Patent
15 4,557,060 to Kawashima, and rejected Claims 10, 12, 13, 41, 43 and 44 under 35 U.S.C. §
16 102(b) as being anticipated by United States 4,211,236 to Krinsky. The Examiner also
17 rejected Claims 11-42 as being obvious under 35 U.S.C. § 103(a) over Krinsky. The
18 Examiner also rejected Claims 14 and 15 as being unpatentable over the Krinsky reference
19 combined with an official notice. The Examiner rejected Claims 1-6, 8-14, 32-37 and 39-45
20 under 35 U.S.C. § 102(a) as being unpatentable over Krinsky in view of the official notice.
21 The Examiner also rejected Claims 1 and 32 under 35 U.S.C. § 103(a) as being unpatentable
22 over the Kawashima reference in view of United States Patent 4,768,295 issued to Ito. The
23 Examiner also rejected Claims 2, 33, 8, 13, 39 and 44 under 35 U.S.C. § 103(a) as being
24 unpatentable as applied to Claims 1, 34, 4, 10, 35, 41 in view of United States Patent
25 5,775,005 to McClelland. The Examiner rejected Claims 3, 34, 9, 14, 40 and 45 under 35
26 U.S.C. § 103(a) as being unpatentable over the references as applied to Claims 1, 32 and 4,
27 10, 35, 41, respectively, and also in view of an official notice.
28

1 The Appellant filed a very extensive amendment responsive to this non-final Office
2 Action on
3 June 12, 2007 setting forth in detail why the references did not disclose or make obvious the
4 present invention. No claims were added, cancelled or amended. The claims are drawn to the
5 same subject matter as recited above.

6 On July 3, 2007, the Examiner issued a final Office Action essentially rejecting all of
7 the claims of invention for exactly the same reasons as set forth in the Office Action mailed
8 on January 30, 2007.

9 The Appellant requested a one-month extension of time and timely filed a Notice of
10 Appeal on October 29, 2007. The current Appeal Brief is now timely submitted with the 60-
11 day time period.

12 The claimed subject matter of Claims 1-14 and 32 - 45 are as follows:

13 Independent Claim 1: Independent Claim 1 claims:

14 A shoe having a shoe sole including an outsole, a midsole, an insole and having a
15 front area over which the toes of a foot rest when the shoe is worn, the improvement
16 comprising:

- 17 a. a non-leaking deformable gel formed within the front area of the sole and
18 aligned with the insole so that the gel is located beneath the toes of the foot
19 when the shoe is worn, so that all five toes rest on the gel and the base of the
20 big toe right below the 1st metatarso-phalangeal joint also rests on the gel;
21 b. whereby the non-leaking deformable gel permits the toes to curl, flex, bend or
22 grasp downward when a wearer of the shoe is walking.

23
24 The support for this claim is found in the patent text, Page 16, Lines 15-26; Page 18,
25 Lines 19-27; Figures 1 - 10, and the patent text, Page 26, Lines 24-28; Page 27, Lines 1-28
26 through patent text, Page 28, Line 1.

27 Dependent Claim 2: Dependent Claim 2 claims the gel being covered with stretch
28 material. There is support for this in the patent text, Page 27, Line 26, through Page 28, Line

1. There is also support for this in the patent text, Page 17, Lines 17-25.

Dependent Claim 3: Dependent Claim 3 claims a gel treated with a fungicide. There is support for this in the patent text on Page 18, Line 26. There is also support for this in the patent text, Page 17, Lines 17-25.

Independent Claim 4: Independent Claim 4 claims:

A shoe having a shoe sole including an outsole, a midsole, an insole and having a front area over which the toes of a foot rest when the shoe is worn, the improvement comprising:

- a. a deformable padding formed within the front area of the sole and aligned with the insole so that the deformable padding is located beneath the toes of the foot when the shoe is worn, so that all five toes rest on the deformable padding and the base of the big toe rests right below the 1st metatarso-phalangeal joint and also rests on the deformable padding; and
- b. the deformable padding is selected from the group consisting of a deformable liquid gel pack, a deformable liquid, a gel pack encased in a stretch Lycra® fabric, silicone, foam, memory foam, soft memory type flexible material, soft rubber, soft synthetic plastic, polyurethane gel, neoprene, polyvinyl, polyethylene or polyurethane;
- c. whereby, the deformable padding permits the toes to curl, flex, bend or grasp downward when a wearer of the shoe is walking.

The support for this claim is found in the patent text, Page 16, Lines 15-26; Page 18, Lines 19-27; Figures 1 - 10, and the patent text, Page 26, Lines 24-28; Page 27, Lines 1-28 through patent text, Page 28, Line 1.

Dependent Claim 5 states that the deformable padding is at least 6mm in depth. There is support for this in the patent text, Page 17, Line 24.

Dependent Claim 6 states that the deformable padding is also aligned with a portion of the midsole in addition to being aligned with the insole. There is support for this in Figure 7

1 and patent text, Page 23, Lines 1-2.

2 Dependent Claim 7 states a cavity formed into the front portion of the shoe to receive
3 the deformable padding. There is support for this in Figure 8 and patent text, Page 23, Lines
4 4-5.

5 Dependent Claim 8 states that the deformable padding is covered with a stretch
6 material. There is support for this in the patent text, Page 27, Line 26, through Page 28, Line
7 1. There is also support for this in the patent text, Page 17, Lines 17-25.

8 Dependent Claim 9 states that the deformable padding is treated with a fungicide.
9 There is support for this in the patent text, Page 18, Line 26. There is also support for this in
10 the patent text, Page 17, Lines 17-25.

11
12 Independent Claim 10: Independent Claim 10 states as follows:

13 A foot wearing item to be worn on a foot, the foot wearing item including an insole
14 against which the foot rests and having a front area over which the toes of the foot rest
15 when the foot wearing item is worn, the improvement comprising:

- 16 a. a flexible and deformable material formed within the front area of the foot
17 wearing item and aligned with the insole so that the flexible material is located
18 beneath the toes of the foot when the foot wearing item is worn so that all five
19 toes rest on the flexible material and the base of the big toe right below the 1st
20 metatarso-phalangeal joint also rests on the flexible material;
21 b. whereby the flexible material permits the toes to curl downward when a wearer
22 of the wearing apparel is walking.

23 The support for this claim is found in the patent text, Page 16, Lines 15-26; Page 18,
24 Lines 19-27; Figures 1 - 10, and the patent text, Page 26, Lines 24-28; Page 27, Lines 1-28
25 through patent text, Page 28, Line 1.

26 Dependent Claim 11 states that the flexible material is selected from the group
27 comprising non-leaking semi-solid gel filled padding, silicone, foam, memory foam, soft
28 rubber, soft synthetic plastic, a gel pack encased in a stretch Lycra® fabric, polyurethane gel,

1 neoprene, polyvinyl, polyethylene or polyurethane. The support for this claim is found in the
2 patent text, Page 17, Lines 17-25, and Page 18, Lines 19-27.

3 Dependent Claim 12 states that the foot wearing item is selected from the group
4 comprising shoes, sandals, flip-flops or athletic shoes. The support for this claim is found in
5 Figures 1-6.

6 Dependent Claim 13 states that the flexible and deformable material is covered with a
7 covering material. The support for this claim is found in the patent text Page 27, Line 26
8 through Page 28, Line 1 and Page 17, Lines 17-25.

9 Dependent Claim 14 states that the flexible and deformable material is treated with a
10 fungicide. The support for this claim is found in the patent text, Page 18, Line 26 and Page
11 17, Lines 17-25.

12 Independent Claim 32: Independent Claims 32 claims the following:

13 A shoe having a shoe sole including an outsole, a midsole, an insole and having a
14 front area over which the toes of a foot rest when the shoe is worn, the improvement
15 comprising:

- 16 c. a non-leaking deformable gel formed within the front area of the sole and
17 aligned with the insole so that the gel is located beneath the toes of the foot
18 when the shoe is worn, so that all five toes rest on the gel;
19 d. whereby the non-leaking deformable gel permits the toes to curl, flex, bend or
20 grasp downward when a wearer of the shoe is walking.

21 The support for this claim is found in the patent text, Page 16, Lines 15-26; Page 18,
22 Lines 19-27; Figures 1 - 10, and the patent text, Page 26, Lines 24-28; Page 27, Lines 1-28
23 through patent text, Page 28, Line 1.

24 Dependent Claim 33: Dependent Claim 2 claims the gel being covered with stretch
25 material. There is support for this in the patent text, Page 27, Line 26, through Page 28, Line
26 1. There is also support for this in the patent text, Page 17, Lines 17-25.

27 Dependent Claim 34: Dependent Claim 3 claims a gel treated with a fungicide. There
28 is support for this in the patent text on Page 18, Line 26. There is also support for this in the

1 patent text, Page 17, Lines 17-25.

2 Independent Claim 35: Independent Claims as follows:

3 A shoe having a shoe sole including an outsole, a midsole, an insole and having a
4 front area over which the toes of a foot rest when the shoe is worn, the improvement
5 comprising:

- 6 a. a deformable padding formed within the front area of the sole and aligned with
7 the insole so that the deformable padding is located beneath the toes of the foot
8 when the shoe is worn, so that all five toes rest on the deformable padding; and
9 b. the deformable padding is selected from the group consisting of a deformable
10 liquid gel pack, a deformable liquid, a gel pack encased in a stretch Lycra®
11 fabric, silicone, foam, memory foam, soft memory type flexible material, soft
12 rubber, soft synthetic plastic, polyurethane gel, neoprene, polyvinyl,
13 polyethylene or polyurethane;
14 c. whereby, the deformable padding permits the toes to curl, flex, bend or grasp
15 downward when a wearer of the shoe is walking.

16
17 Dependent Claim 36 states that the deformable padding is at least 6mm in depth.

18 There is support for this in the patent text, Page 17, Line 24.

19 Dependent Claim 37 states that the deformable padding is also aligned with a portion
20 of the midsole in addition to being aligned with the insole. There is support for this in Figure
21 7 and patent text, Page 23, Lines 1-2.

22 Dependent Claim 38 states a cavity formed into the front portion of the shoe to receive
23 the deformable padding. There is support for this in Figure 8 and patent text, Page 23, Lines
24 4-5.

25 Dependent Claim 39 states that the deformable padding is covered with a stretch
26 material. There is support for this in the patent text, Page 27, Line 26, through Page 28, Line
27 1. There is also support for this in the patent text, Page 17, Lines 17-25.

28 Dependent Claim 40 states that the deformable padding is treated with a fungicide.

1 There is support for this in the patent text, Page 27, Line 26, through Page 28, Line 1. There is
2 also support for this in the patent text, Page 17, Lines 17-25.

3
4 Independent Claim 41: Independent Claim 41 claims as follows:

5 A foot wearing item to be worn on a foot, the foot wearing item including an insole
6 against which the foot rests and having a front area over which the toes of the foot rest
7 when the foot wearing item is worn, the improvement comprising:

- 8 a. a flexible and deformable material formed within the front area of the foot
9 wearing item and aligned with the insole so that the flexible material is located
10 beneath the toes of the foot when the foot wearing item is worn so that all five
11 toes rest on the flexible material;
12 b. whereby the flexible material permits the toes to curl downward when a wearer
13 of the wearing apparel is walking.

14
15 The support for this claim is found in the patent text, Page 16, Lines 15-26; Page 18,
16 Lines 19-27; Figures 1 - 10, and the patent text, Page 26, Lines 24-28; Page 27, Lines 1-28
17 through patent text, Page 28, Line 1.

18 Dependent Claim 42 states that the flexible material is selected from the group
19 comprising non-leaking semi-solid gel filled padding, silicone, foam, memory foam, soft
20 rubber, soft synthetic plastic, a gel pack encased in a stretch Lycra® fabric, polyurethane gel,
21 neoprene, polyvinyl, polyethylene or polyurethane. The support for this claim is found in the
22 patent text, Page 17, Lines 17-25, and Page 18, Lines 19-27.

23 Dependent Claim 43 states that the foot wearing item is selected from the group
24 comprising shoes, sandals, flip-flops or athletic shoes. The support for this claim is found in
25 Figures 1-6.

26 Dependent Claim 44 states that the flexible and deformable material is covered with a
27 covering material. The support for this claim is found in the patent text, Page 27, Line 6 to
28 Page 28, Line 1 and Page 17, Lines 17-25.

1 Dependent Claim 45 states that the flexible and deformable material is treated with a
2 fungicide. The support for this claim is found in the patent text page Page 18, Line 26.

3 The Examiner rejected the claims on the second non-final action for reasons that were
4 different than the original rejection on the first non-final action. Therefore, since the citations
5 of the first non-final action were withdrawn, it is only the patents and published applications
6 cited the second non-final action that will be addressed in this Appeal Brief. The Appellant
7 will set forth in Section V the Examiner's grounds for rejection and the very detailed
8 arguments presented by the Appellant in Section VII which essentially are very similar to the
9 arguments presented in the amendment mailed to the Patent Office on June 12, 2007. The
10 Appellant respectfully points out that the Examiner is simply incorrect in his final rejection
11 for the reasons as set forth in detail in Sections VI and VII below.

12
13 **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL -**
14 **37 C.F.R. § 41.37(c)(1)(vi)**
15

16 A. In the Office Action mailed July 3, 2007, which was a final rejection, Patent Examiner
17 Kavanaugh rejected all twenty eight (28) claims of invention for the following reasons:

18 1. Claims 4, 6, 7, 10, 11, 12, 35, 37, 38, 41, 42, and 43 were rejected under 35
19 U.S.C. § 102(b) as being clearly anticipated by Kawashima, United States Patent 4,557,060.
20 The Examiner believed that the shape, appearance, and claims of Roberts-Shea is identical in
21 all material respects to that of the claimed design. As will be set forth in the arguments
22 below, the Appellants respectfully disagree with the Examiner's reasoning. Rather than
23 repeat everything that is going to be presented in the arguments for allowance, the Appellants
24 respectfully refer to Section VII on allowance where everything that is stated by the Examiner
25 is repeated and discussed in detail, item by item, as to why the claims are allowable.

26 2. The Examiner further rejected Claims 10, 12, 13, 41, 43, and 44 under 35
27 U.S.C. § 102(b) as being clearly anticipated by Krinsky, United States Patent 4,211,236. The
28 Examiner believed that the pad of Krinsky that resides under the entire foot and the highly

1 viscous material of Krinsky is identical in all material respects to that of the claimed design.
2 As will be set forth in the arguments below, the Appellants respectfully disagree with the
3 Examiner's reasoning. Rather than repeat everything that is going to be presented in the
4 arguments for allowance, the Appellants respectfully refer to Section VII on allowance where
5 everything that is stated by the Examiner is repeated and discussed in detail, item by item, as
6 to why the claims are allowable.

7 3. The Examiner also rejected Claims 11 and 42 under 35 U.S.C. § 103(a) as
8 being unpatentable over Krinsky, United States Patent 4,211,236. The Examiner states that
9 although the invention is not identically disclosed in Krinsky, the Examiner believes that the
10 difference between the subject matter to be patented and this prior art is such that the subject
11 matter as a whole would have been obvious at the time the invention was made to a designer
12 having ordinary skill in the art. Once again, the Appellants go into great detail, addressing
13 every single point raised by the Examiner with respect to the Kaplan reference in the
14 arguments on grounds for rejection and respectfully refers to Section VII of this brief.

15 4. The Examiner also rejected Claims 1-6, 8-14, 32-37, 39-45, under 35 U.S.C. §
16 103(a) as being unpatentable over Krinsky, United States Patent 4,211,236, in view of official
17 notice. The Examiner believes that shoe pads are old and convention in the art to provide
18 shoe pads with a fungicide. The Examiner also states that placing a deformable padding in a
19 shoe having an insole, midsole, and outsole is old in the art and that placing the cushion on
20 top of the insole and therefore aligning with the insole is obvious. Once again, the Appellants
21 go into great detail, addressing every single point raised by the Examiner with respect to the
22 Kaplan reference in the arguments on grounds for rejection and respectfully refers to Section
23 VII of this brief.

24 5. The Examiner also rejected Claims 1 and 32 under 35 U.S.C. § 103(a) as being
25 unpatentable over Krinsky, United States Patent 4,211,236, in view of Ito, United States
26 Patent 4,768,295. The Examiner states that Ito teaches a gel filled cavity of a shoe sole, and,
27 thus, it would be obvious to place the Ito gel in the Kawashima sole. Once again, the
28 Appellants go into great detail, addressing every single point raised by the Examiner with

1 respect to the Kaplan reference in the arguments on grounds for rejection and respectfully
2 refers to Section VII of this brief.

3 6. The Examiner also rejected Claims 5 and 36 under 35 U.S.C. § 103(a) as being
4 unpatentable over Kawashima, and as applied to Claims 1,4,10, 32, 35, and 41 in view of
5 McClelland, United States Patent Number 5,775,005. The Examiner believes that the
6 conventional sock liner of McClelland makes the material of the present invention obvious.
7 Once again, the Appellants go into great detail, addressing every single point raised by the
8 Examiner with respect to the Kaplan reference in the arguments on grounds for rejection and
9 respectfully refers to Section VII of this brief.

10 7. The Examiner also rejected Claims 3, 9, 14, 34, 40 and 45 under 35 U.S.C. §
11 103(a) as being unpatentable over the references, and as applied to Claims 1,32 and 4, 10, 35
12 and 41 respectively above, and further in view of Official Notice. The Examiner sates that it
13 is old and conventional in the art to provide shoe pads, cushions, insole, etc. with a fungicide
14 and, therefore, it would have been obvious to provide the deformable padding as taught above
15 with a fungicide. Once again, the Appellants go into great detail, addressing every single
16 point raised by the Examiner with respect to the Kaplan reference in the arguments on
17 grounds for rejection and respectfully refers to Section VII of this brief.

18 **B. Concise Statement For Grounds Of Rejection To Be Reviewed On Appeal.**

19 The Examiner's primary argument is that the voluminous distinctions the
20 Appellant had made between the cited prior art and the present invention are not specific
21 distinctions to render the claims patentable over any applied references and suggests
22 that these distinctions be added to the claims of the present invention. The Examiner
23 continues stating that even if the claims were amended to reflect these distinctions, the
24 Examiner would still reject all the claims. The Appellant respectfully disagrees with
25 the Examiner and suggests that all the distinctions made by the Appellant are specific and
26 do render the claims of the present invention patentable over the applied references. The
27 Appellant hesitates to make the suggested amendments to the Claims, particularly because the
28 Examiner has stated that he would reject the claims regardless of the amendments. The

Appellant respectfully seeks the Appeal Board's determination in resolving these issues.

VII. ARGUMENT - 37 C.F.R. SECTION 41.37(1)(c)(vii)

The Appellants will now present detailed arguments why each of the claims are separately allowable over the cited prior art references.

1. General Arguments for Allowance of Claims 4, 6, 7, 10, 11, 12, 35, 37, 38, 41, 42, and 43 as Being Rejected Under 35 USC 102(b) as Being Anticipated by Kawashima

Because the Examiner has set forth arguments on all of these claims based upon one single reference, in the interests of efficiency, the Appellant will address all of the arguments by the Examiner in the order in which they appear in the final Office Action mailed July 3, 2007 as they relate all of these claims.

Claims 4, 6, 7, 10, 11, 12, 35, 37, 38, 41, 42, and 43 are rejected under 35 USC 102(b) as clearly anticipated by United States Patent 4,557,060 issued to Kawashima on December 10, 1985 for "INSOLE WITH EXCHANGEABLE RELIANT PIECES" (hereafter "Kawashima").

A comparison of the Appellant's drawings and Figures 2, 6, 10, 16, and 17 compared to the Kawashima drawings in Figures 1 through 5 clearly illustrate that the two inventions are absolutely and totally different and have nothing whatsoever to do with each other. The Appellant will now present more detailed arguments to explain why the present invention is not obvious in view of the Kawashima reference and, further, will address all of the Examiner's arguments point by point.

First, the proper rule for anticipation is a three prong test. Federal Circuit decisions have repeatedly emphasized that anticipation is established only if (1) all the elements of an invention, as stated in a patent claim, (2) are identically set forth, (3) in a single prior art. *American Permahedge, Inc. v. Barcana, Inc.*, 857 F. Supp. 308, 318, 32 USPQ2d 1801, 1807-

08 (SDNY 1994) ("Prior art anticipates an invention . . . if a single prior art reference contains each and every element of the patent at issue, operating in the same fashion to perform the identical function as the patented product. . . . Thus, any degree of physical difference between the patented product and the prior art, *no matter how slight*, defeats the claim of anticipation."); *Acromed Corp. v. Sofamor Danek Group, Inc.*, 253 F.3d 1371, 1383, 59 USPQ2d 1130 (Fed. Cir. 2001) ("Normally, to invalidate a patent by anticipation a prior art reference needs to disclose each and every limitation of the claim."); *Eli Lilly & Co. v. Barr Laboratories, Inc.*, 251 F.3d 955, 970, 58 USPQ2d 1865 (Fed. Cir. 2001), *cert. denied*, 122 S. Ct. 913 (2002) ("A reference is anticipatory if it discloses every limitation of the claimed invention either explicitly or inherently."); *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 20, 57 USPQ2d 1057, 1061 (Fed. Cir. 2000) ("Anticipation under 35 U.S.C. § 102 requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention"). *Gechter v. Davidson*, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997) ("Under 35 U.S.C. § 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim."); *Novo Nordisk A/S v. Becton Dickinson L& Co.*, 96 F. Supp.2d 309, 312 (SDNY 2000) ("It is not sufficient that each element be found somewhere in the reference, the elements must be 'arranged as in the claim.'") (internal citation omitted.); *Levi Strauss & Co. v. Golden Trade, S.r.L.*, 1995 WL 710822 *30 (SDNY 1994) ("Identity requires not only that every element of the claimed invention appear in a single prior art reference, but that they appear in the same order as in the claims."); *Gillette Co. v. Warner-Lambert Co.*, 690 F. Supp. 115, 117 8 USPQ2d 1082, 1084 (D. Mass. 1988) ("Not only must all claimed elements be present in the prior device, but the elements must be found in substantially the same situation where they do substantially the same work."); *Datascope Corp. v. SMEC, Inc.*, 224 USPQ 694, 698 (D. NJ 1984), *aff'd in part & rev'd in part*, 776 F.2d 320, 227 USPQ 838 (Fed. Cir. 1985) ("Anticipation cannot be predicated on teachings in a reference that are vague or based on conjecture").

The Appellants will now demonstrate that, in light of the case law above, the Kawashima reference does not anticipate the present invention.

1 First, an examination of Kawashima shows it to be a utility patent teaching an
2 insertable, interchangeable, shock absorbing insole comprised of "exchangeable piece[s] of
3 resilient foam synthetic resin having higher durometer hardness than that of an insole body
4 and inserted in a recess formed in the insole body." (Col. 1, lines 31-35). It is abundantly
5 clear that what Kawashima had in mind was to take a shoe sole, which is to be inserted into a
6 shoe and which is used in addition to the shoe sole that is already incorporated into the shoe,
7 and adapt it so that it provides a cushioning support pad for two areas of the foot so that the
8 entire assembly provides a customizable and adaptable cushioning and shock absorption for
9 the forefoot and heel areas of the foot, particularly adaptable to suit the shock absorption
10 requirements. It is clear from just an examination of the drawings of the present invention
11 alone, that the present invention is completely different from Kawashima. The shoe sole of
12 the present invention does not provide cushioning for two areas of the foot, but instead is
13 under one section of the foot, specifically the toes, beginning along the area along the upper
14 border of the ball of the foot at the base of the toes starting right below and including the ball
15 of the big toe and the other digits and extending to at least the ends of the toes; the portion
16 under the toes is not for cushioning or shock absorption, but instead is for tactile sensory
17 stimulation of the toes; the toe support of the present invention does not provide shock
18 absorption that is adaptable and interchangeable to suit specific sports requirements, but
19 instead disperses the load forces by the toes during the grasping-gripping motion of the toes
20 during walking. Therefore, it is abundantly clear that the cushioning elements of the
21 Kawashima insole are completely different from the cushioning element of the present
22 invention.

23 Kawashima has only one independent claim, which reads:

- 24 1. An insole for a shoe, said insole comprising:
25 a body made of one of thermoplastic and thermosetting foam synthetic resin, said
26 body including a heel area and a forefoot are having a top surface and a bottom surface,
27 two recesses defined by said body located on one of the top surface and the bottom
28 surface of said body, one of said two recesses being located at said heel area of said body and

1 being spaced from the sides of said body, the other of said two recesses being located at a
2 forefoot are of said body and extending laterally to opposed side edges of said body,
3 two resilient member having a different durometer hardness than that of said body,
4 said two resilient members being complementary in shape to said two recesses for frictionally
5 engaging said two recesses, and

6 said body includes a projection spaced from the peripheral edge of said one of said
7 two recesses and projecting into said one recess, the resilient member complementary in
8 shape to said one of said two recesses defines a hole frictionally engaging said projection,
9 said body also includes two wedges, each wedge extending from opposed lateral edges of said
10 other of said two recesses and the resilient member complementary in shape to said other of
11 said two recesses defining tow notches frictionally engaging said two wedges.

12
13 In comparing the independent claim of Kawashima to the independent claims of the
14 present invention, it is clear that the claims of the present invention does not fit into the rule
15 set forth by the courts requiring that (1) all the elements of an invention, as stated in a patent
16 claim, (2) are identically set forth, (3) in a single prior art. In order for Kawashima to
17 anticipate the present invention, all the claims of the present invention must be identically set
18 forth in Kawashima. It is clear from a review of the independent claims, that all the claims of
19 the present invention are not identically set forth in Kawashima. Because all the claims of the
20 present invention are not identically set forth in Kawashima, Kawashima does not anticipate
21 the present invention. Because Kawashima does not anticipate the present invention, the
22 Appellant respectfully requests that the claims be allowed.

23
24 In addition, numerous physical differences, both slight and considerable, exist
25 between Kawashima and the present invention.

26 Referring to Figures 1 through 5, the Kawashima design illustrates the cushion inserts
27 to be comprised of the same foam synthetic resin of which the molded insole body is
28 comprised, the difference between the two being that the cushions are of a higher durometer

1 hardness than that of the insole body. The Kawashima design requires the two cushion pads
2 to be made of foam resin. It is abundantly clear that what Kawashima intended was to have
3 the shoe insert designed in such a manner as to also provide, not just support for the foot, but
4 specific and advantageous shock absorption and improved responses to the foot strike under
5 the heels of the foot and under the balls of the foot during sports activities. An examination
6 of the present invention, as well as Figures 2, 6, and 10, shows very clearly that the toe
7 cushion is not made of the same material as the body of the shoe insert, but is instead made of
8 a deformable gel, which is a different material from the body of the sole; the toe cushion of
9 the present invention does not provide cushioning under the heel and under the balls of the
10 foot, but, instead, lies immediately under the toes of the foot only, and provides a means for
11 the toes to perform the natural grasping-gripping motion during walking. Therefore, it is
12 abundantly clear that the cushioning elements of the Kawashima design is composed of a
13 totally different material and serves a totally different purpose than that of the present
14 invention. Therefore, it is abundantly clear that the cushioning elements of the Kawashima
15 insole are completely different from the cushioning element of the present invention.

17 In addition, referring to Figures 1, 2, and 3, and Column 1, line 65 through Column 2,
18 line 3, the Kawashima design teaches that the cushioning elements of the Kawashima insole
19 fit into the body of the insole, as well as being held in the body of the insole, by means of a
20 combination of projections 6 and 6' that around which the notches 7 and 7' of the insertable
21 cushions fit. It is clear that what Kawashima intended was to have the cushioning elements
22 for the heel and the balls of the foot to be interchangeable and to provide a means to prevent
23 lateral movement of the cushion inserts. Therefore, the cushioning elements are inserted into
24 the body of the insole like pieces of a puzzle and held in place by means of these projections
25 and notches. An examination of the present invention, as well as figures 1, 8, 12, 19, and 20,
26 clearly show that the toe cushion does not utilize a series of projections and corresponding
27 notches to retain the toe cushion in place, but instead, is built inside, inserted inside, or
28 engineered inside a chamber or cavity inside the shoe sole area, with said chamber or cavity

1 being without any projection and with said insert without any notches. It is further clear that
2 the cushioning element of the present invention is not related to the manner of retaining the
3 toe cushion in the insole or the appearance of the toe cushion related to the manner of
4 retaining the toe cushion in the insole. Therefore, it is abundantly clear that the cushioning
5 elements of the Kawashima insole are completely different from the cushioning element of
6 the present invention.

7 In addition, referring to Figure 5, the Kawashima design illustrates that the cushioning
8 elements of the Kawashima insole is designed in such a manner that the insole can also be
9 effective, in its present design, if the insole is inserted into the shoe upside down, such that
10 the upper surface of the cushioning elements are facing and touching the interior surface of
11 the sole of the shoe. Further, the cushioning elements of Kawashima do not occupy the entire
12 depth of the insole, but instead, only occupy a portion of the depth of the body of the insole
13 having the remainder of the depth a continuation of the body of the insole. Therefore, the
14 cushioning elements are lodged within the body of the insole and do not pass through and
15 therefore, when the insole is placed in the shoe upside down, as shown in Figure 5, the foot of
16 the wearer does not come into direct contact with the cushioning elements of the Kawashima
17 design. An examination of the present invention, as well as Figures 2, 6, 10, 16, and 17,
18 clearly shows that the toe cushion cannot be placed upside down, but instead, the present
19 invention requires that the that the toe cushion must be in immediate contact with the toes of
20 the wearer; so as to enable the toes to perform the natural grasping-gripping motion during
21 walking. Therefore, it is abundantly clear that the cushioning elements of the Kawashima
22 patent are designed in a completely different manner and serve a totally different purpose.
23 Therefore, it is abundantly clear that the cushioning elements of the Kawashima insole are
24 completely different from the cushioning element of the present invention.

25 In addition, referring to Col. 2, lines 4-7, and Col. 1, lines 61-64, the Kawashima
26 design teaches that the insertable insole is provided with several pairs of resilient pieces of
27 differing hardness and elasticity to be inserted into the recesses of the body of the insole to
28 suit the sport and the user's weight. It is clear that what Kawashima intended is to have an

1 insertable insole that is designed to be worn specifically during sports that has
2 interchangeable pieces of differing hardness and elasticity of cushioning for under the heel
3 and the balls of the foot. It is clear that the Kawashima design is a sports insole that the user
4 may customize by changing the cushions under the heel and balls of the foot, as according to
5 the needs of the sport. An examination of the present invention, including Figures 6, 10 and
6 17, clearly shows that the toe cushion of the present invention is not designed to provide
7 cushioning for the heel and the balls of the foot to be customized for use in sports, but instead
8 is to facilitate the grasping-gripping function of the toes; the toe cushion of the present
9 invention is not customizable for sports, but instead is designed to improve the natural
10 walking function via the toe cushion to allow the natural grasping-gripping motion of the toes.
11 Therefore, it is abundantly clear that the cushioning elements of the Kawashima insole are
12 completely different from the cushioning element of the present invention.

13 Because of the foregoing, it is abundantly clear that the Kawashima patent in no way
14 anticipates the present invention by any of the case law or by any similarity, as Kawashima
15 teaches a design that is completely and totally dissimilar from the present invention and has
16 claims into which the claims of the present invention do not reside. The Appellant
17 respectfully suggests that Kawashima cannot and does not anticipate the present invention
18 and respectfully requests that Claims 4, 6, 7, 10, 11, 12, 35, 37, 38, 41, 42, and 43 be
19 admissible.

20 2. General Arguments for Allowance of Claims 10, 12, 13, 41, 43, and 44 as
21 Being Rejected Under 35 USC 102(b) as Being Anticipated by Krinsky
22

23 Because the Examiner has set forth arguments on all of these claims based upon one
24 single reference, in the interests of efficiency, the Appellant will address all of the arguments
25 by the Examiner in the order in which they appear in the final Office Action mailed
26 July 3, 2007 as they relate all of these claims.

27 Claims 10, 12, 13, 41, 43 and 44 are rejected under 35 USC 102(b) as clearly
28 anticipated by United States Patent 4,211,236 issued to Krinsky on July 8, 1980 for

1 "ORTHOPEDIC CUSHION AND METHOD FOR FITTING THEREOF"(hereafter
2 "Krinsky").

3 The Appellant herein incorporates in full the three prong test and the case law cited
4 above. To reiterate the basic three prong test, anticipation is established only if (1) all the
5 elements of an invention, as stated in a patent claim, (2) are identically set forth, (3) in a
6 single prior art. A

7 Krinsky has six independent claims. By way of example, the first independent claim
8 reads as follows:

9 1. An orthopedic cushion, useful for fitting to a user's foot or against other portions of a
10 user's body, comprising:

11 a unitary structure including:

12 a flexible envelope, the envelope defining an interior volume;

13 an elongated member outwardly extending from [sic] the envelope, the

14 elongated member including a narrow passageway communicating at one end
15 with the envelope interior volume; and

16 a diverticulum, the diverticulum opening off of the passageway at the
17 passageway other end and being spaced outward of the flexible envelope and
18 away from that portion of the envelope against which the user's foot or other
19 portions of the user's body will bear, the diverticulum, the passageway, and the
20 envelope volume all under partial vacuum; and

21 a non-set and flowable, highly viscous material, the viscous material of a
22 predetermined amount overfilling the envelope volume and within the
23 passageway.

24
25 For Krinsky to anticipate the present invention, all the claims of the present invention
26 must be identically set forth in Krinsky. A review of the independent claims of the present
27 invention as compared with the independent claims of Krinsky, in light of the three prong test
28 and case law, clearly show that the all the claims of the present invention, or the claims cited

1 by the Examiner, are not identically set forth in Krinsky. Krinsky's other independent claims,
2 claims 7, 9, 11, 13, and 15 are similarly stated and a review of those independent claims will
3 also show that all the claims of the present invention are not identically set forth in Krinsky,
4 and therefore, Krinsky fails the three prong test for anticipation. Because Krinsky fails the
5 test for anticipation, Krinsky does not anticipate the present invention and the claims of the
6 present invention are allowable.

7 Additionally, numerous physical differences exist between Krinsky and the present
8 invention and those differences further negate the assertion of Krinsky's anticipation of the
9 present invention.

10 A review of the Appellant's drawings and see Figures 2, 6, 7, 8, 10, 16, and 17
11 compared to the Krinsky drawings in Figures 1 through 7 clearly illustrate that the two
12 inventions are absolutely and totally different and have nothing whatsoever to do with each
13 other. The Appellant will now present more detailed arguments to explain to the Examiner
14 why the two inventions are totally dissimilar and why the present invention is not obvious in
15 view of the Krinsky reference.

16 First, an examination of Krinsky shows it to be a utility patent teaching an adjustable
17 cushion that cushions the entire bottom surface of the foot and is adjusted by means of adding
18 to or removing from the quantity of highly viscous material within the interior of the cushion.

19 It is abundantly clear that what Krinsky had in mind was to take a pouch filled with a
20 liquid gel, wherein the quantity of gel is adjustable, and place it inside a shoe wherein it
21 resides under the entirety of the foot so as to provide support and stability for the foot. It is
22 clear from just an examination of the drawings of the present invention alone, that the present
23 invention is completely different from Krinsky. The shoe sole of the present invention does
24 not provide cushioning for the entire area under the foot, but instead is under one section of
25 the foot, specifically the toes; the portion under the toes is not for cushioning, but instead is
26 for tactile sensory stimulation of the toes; the toe support of the present invention does not
27 provide stability and cushioning for the foot, but instead disperses the load forces by the toes
28 during the grasping-gripping motion of the toes during walking.

1 In addition, referring to Figures 1 through 7, the Krinsky design illustrates the cushion
2 to be comprised of dual chambers into which the lesser chamber may either receive excess gel
3 from the main chamber or from which the lesser chamber may inject more gel into the main
4 chamber. The Krinsky design requires that the cushioning element be adjustable. To achieve
5 the required adjustability, Krinsky requires that the gel "remains flowable and does not set
6 within the envelope" (Col. 4, lines 14, 15). Further, Krinsky requires that the envelope be air
7 tight to enable the volume of gel to be "preferably all under partial vacuum" (Col. 4, lines 28-
8 29). Further, the means for making the adjustments requires the addition of a diverticulum to
9 the vacuumed, cushioning element, so as to pump gel in to the main chamber or to suck gel
10 out of the main chamber. Further, Krinsky teaches the method for fitting the orthopedic
11 cushion is that "the cushion can be placed in a shoe and the foot placed thereover while the
12 member [the diverticulum] proceeds upwardly along the side of the foot and out of the shoe
13 adjacent the inner portion of the ankle joint." (Col. 3, lines 25-29). The shoe sole of the
14 present invention does not have an adjustable cushion, but instead is not adjustable. The shoe
15 sole of the present invention is not comprised of dual chambers, but instead is a single cell.
16 The shoe sole of the present invention does not require, nor is it under, partial vacuum, but
17 instead is under normal atmospheric pressure. The shoe sole of the present invention does not
18 have a gel that is capable of flowing movement or complete displacement, but instead is a
19 deformable gel that is less viscous than that of the Krinsky design. The shoe sole of the
20 present invention does not have a diverticulum to facilitate the exchange of gel, but instead is
21 merely a single, crescent shaped cell that contains the full requirement of interior material to
22 which none is added or removed after manufacture. Further, the present invention is not a
23 method to fit the cushion, but instead is a device to provide tactile stimulation to the pads of
24 the toes. Therefore, it is abundantly clear that the cushioning element of the Krinsky cushion
25 is entirely different from the cushioning element of the present invention. It is further
26 apparent that the Krinsky patent is totally and completely different from the present invention
27 in every respect and has nothing whatsoever to do with the present invention.
28

1 Because of the foregoing, it is abundantly clear that the Krinsky patent in no way
2 anticipates the present invention by any of the case law or by any similarity, as Krinsky
3 teaches a design that is completely and totally dissimilar from the present invention with
4 numerous physical differences and has claims into which the claims of the present invention
5 do not reside. The Appellant respectfully suggests that Krinsky cannot and does not
6 anticipate the present invention and respectfully requests that Claims 10, 12, 13, 41, 43 and 44
7 be admissible.

8 **3. General Arguments for Allowance of Claims 11 and 42 Being Rejected**
9 **Under 35 U.S.C. § 103(a) as Being Unpatentable Over Krinsky**

10 The Examiner rejects Claims 11 and 42 as being obvious under 35 USC § 103(a) in
11 light of Krinsky. However, the Examiner does not discuss Krinsky in light of the case law.
12 There are four “factual inquiries” from Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459
13 (1966), for the determination of obviousness, which are (1) determining the scope and
14 contents of the prior art; (2) ascertaining the differences between the prior art and the claims
15 at issue; (3) resolving the level of ordinary skill in the pertinent art; (4) considering objective
16 evidence present in the application indicating obviousness or nonobviousness. These four
17 factual inquiries are “indicia of obviousness or nonobviousness [that] may have relevancy.”
18 Id. at 18.

19 The scope and contents of Krinsky is best described in its abstract:

20 An orthopedic cushion, both fittable as well as fitted, for a portion of a user’s body
21 such as a user’s foot, and a method for fitting thereof. The fittable orthopedic cushion
22 comprises a flexible envelope containing a flowable, highly viscous material. The envelope
23 includes an elongated member and a diverticulum which may receive part of the viscous
24 material during adjustment of the cushion to comfortably accommodate the portion of the
25 user’s body. The elongated member and diverticulum of the fittable cushion may be sealed
26 off from the envelope and removed, resulting in a fitted orthopedic cushion, the envelope of
27 which will contain a desired amount of the viscous material.

28 It can be seen that the scope and contents of Krinsky’s teachings is an envelope

1 “formed of a flexible material such as various plastics, for example polyvinyl chloride film or
2 sheeting or polyester film” (Col. 3. Lines 5-8) for the purpose not just providing a contained
3 area for the gel but mainly to create an airtight envelope in which a “partial vacuum” (Col. 4,
4 line 29). Thus, the plastic film or sheeting is not the cover for the flexible and deformable
5 material, but is an essential and integral part of that which comprises the flexible and
6 deformable portion of the Krinsky cushion. Krinsky requires some other covering material to
7 be placed over the plastic cushion or else the user’s foot would reside directly on the plastic.
8 Krinsky requires a covering material over the plastic to prevent the foot sticking to the plastic,
9 to prevent the foot from developing blisters, and to absorb the sweat and odors of the foot.
10 Additionally, Krinsky requires a gel material that is so viscous that it can flow freely from one
11 chamber to another and can flow through a passageway into a diverticulum.. Once filled with
12 the viscous material, the passageway and the diverticulum are removable from the shoe insert
13 and the shoe insert can then be sealed off.

14 The differences between Krinsky and the present invention are numerous.
15 Specifically with regard to the differences between Krinsky and Claims 11 and 42 of the
16 present invention, the differences are equally numerous and significant. As stated above,
17 Krinsky requires a gel material that is so viscous that it can flow freely from one chamber to
18 another. The present invention in Claims 11 and 42 describe semi-solid gels, and solid, but
19 deformable, foams, rubber, and plastics, whose volumes may be deformed but are incapable
20 of easily having volumes that are flowable back and forth between two chambers. The gel in
21 Krinsky must not only be highly viscous, but also severable. Krinsky also requires that the
22 shoe insert have a passageway and diverticulum so that the user may add to or remove from
23 the quantity of highly viscous gel in the insert. The gel must be able to cleanly break off from
24 itself so that when the passageway and diverticulum are removed, the gel will cleanly break,
25 yet not continue to ooze during the time the passageway is removed and the shoe insert is
26 sealed off. The gel of the present invention is a semi-solid or deformable solid material
27 having a quantity that is predetermined and unchangeable. It is abundantly clear that the
28 Krinsky design teaches a gel that is completely and totally different from the present

1 invention.

2 The level of skill in Krinsky is relatively low. The parts of the Krinsky insert, such as
3 the passageway and the diverticulum, as simple designs and simple pieces. The shape,
4 placement, location and contents of the Krinsky insert are very general. The Krinsky insert is
5 similar to walking on a water bed. Despite this relatively low level of skill, Krinsky never
6 contemplated isolating certain portions of the foot, namely the toes. Krinsky never
7 contemplated addressing the needs of, for example, diabetics who need to stimulate their toes
8 to maintain circulation. The present invention also has a relatively low level of skill,
9 however, the skill applied is much higher than that of Krinsky. The present invention has
10 considered the actual formation and location of the bones in the foot. The present invention
11 has applied ergonomic principles in its application. The present invention has had clinical
12 studies performed and has made improvements based thereon. The level of skill between the
13 present invention and Krinsky is very different with different principles applied. Because of
14 the difference in the level of skill applied in the two inventions, Krinsky is incapable of
15 contemplating the needs and applications and claims of the present invention.

16 There are may examples of objective evidence present in the present invention that
17 indicate the nonobviousness of the present invention as compared to Krinsky, and, in
18 particular, objective evidence of nonobviousness with regard to Claims 11 and 42 of the
19 present invention. First, an examination of Krinsky shows it to be a utility patent teaching
20 an adjustable cushion that cushions the entire bottom surface of the foot and is adjusted by
21 means of adding to or removing from the quantity of highly viscous material within the
22 interior of the cushion. Krinsky contemplates a pouch filled with a liquid gel, wherein the
23 quantity of gel is adjustable, and place it inside a shoe wherein it resides under the entirety of
24 the foot so as to provide support and stability for the foot. It is clear from just an examination
25 of the drawings of the present invention alone, that the present invention is completely
26 different from Krinsky. The shoe sole of the present invention does not provide cushioning
27 for the entire area under the foot, but instead is under one section of the foot, specifically the
28 toes; the portion under the toes is not for cushioning, but instead is for tactile sensory

1 stimulation of the toes; the toe support of the present invention does not provide stability and
2 cushioning for the foot, but instead disperses the load forces by the toes during the grasping-
3 gripping motion of the toes during walking.

4 Additionally, referring to Figures 1 through 7, the Krinsky design illustrates the
5 cushion to be comprised of dual chambers into which the lesser chamber may either receive
6 excess gel from the main chamber or from which the lesser chamber may inject more gel into
7 the main chamber. The Krinsky design requires that the cushioning element be adjustable. To
8 achieve the required adjustability, Krinsky requires that the gel "remains flowable and does
9 not set within the envelope" (Col. 4, lines 14, 15). Further, Krinsky requires that the envelope
10 be air tight to enable the volume of gel to be "preferably all under partial vacuum" (Col. 4,
11 lines 28-29). Further, the means for making the adjustments requires the addition of a
12 diverticulum to the vacuumed, cushioning element, so as to pump gel in to the main chamber
13 or to suck gel out of the main chamber. Further, Krinsky teaches the method for fitting the
14 orthopedic cushion is that "the cushion can be placed in a shoe and the foot placed thereover
15 while the member [the diverticulum] proceeds upwardly along the side of the foot and out of
16 the shoe adjacent the inner portion of the ankle joint." (Col. 3, lines 25-29). The shoe sole of
17 the present invention does not have an adjustable cushion, but instead is not adjustable. The
18 shoe sole of the present invention is not comprised of dual chambers, but instead is a single
19 cell. The shoe sole of the present invention does not require, nor is it under, partial vacuum,
20 but instead is under normal atmospheric pressure. The shoe sole of the present invention does
21 not have a gel that is capable of flowing movement or complete displacement, but instead is a
22 deformable gel that is less viscous than that of the Krinsky design. The shoe sole of the
23 present invention does not have a diverticulum to facilitate the exchange of gel, but instead is
24 merely a single, crescent shaped cell that contains the full requirement of interior material to
25 which none is added or removed after manufacture. Further, the present invention is not a
26 method to fit the cushion, but instead is a device to provide tactile stimulation to the pads of
27 the toes. Therefore, it is abundantly clear that the cushioning element of the Krinsky cushion
28 is entirely different from the cushioning element of the present invention. It is further

1 apparent that the Krinsky patent is totally and completely different from the present invention
2 in every respect and has nothing whatsoever to do with the present invention.

3
4 The Appellant respectfully submits that there is ample objective evidence of indicia of
5 nonobviousness in the present invention as compared to Krinsky and, therefore, the claims of
6 the present invention are not made obvious by Krinsky. The Appellant respectfully suggests
7 that claims 11 and 42 of the present invention are allowable and be admitted.

8
9 4. General Arguments for Allowance of Claims 14 and 45 Being Rejected
10 Under 35 U.S.C. § 103(a) as Being Unpatentable Over Krinsky in view of
11 Official Notice

12 The Appellant herein incorporates the above arguments regarding the evidence of
13 nonobviousness of the present invention over Krinsky.

14 Applying the four indicia of obviousness or nonobviousness, discussed above,
15 specifically to claims 14 and 45 of the present invention, the scope and contents of Krinsky
16 are as stated above, and, with regard to Claims 14 and 45, Krinsky teaches a footwear item
17 having the flexible and deformable material treated with a fungicide as an insole for the entire
18 foot.. The major differences between the present invention and Krinsky, in addition to those
19 discussed previously, include that the present invention is a particular device for tactile
20 stimulation of the pads of the toes during the grasping-gripping motion that occurs during
21 walking. While the present invention does lie within a shoe, it is essentially and primarily a
22 means to provide tactile stimulation to the toes and a physical means to recreate the grasping-
23 gripping motion of the toes. The level of skill involved in the two inventions are as stated
24 above. Again, the level of skill in Krinsky is relatively low. The parts of the Krinsky insert,
25 such as the passageway and the diverticulum, as simple designs and simple pieces. The
26 shape, placement, location and contents of the Krinsky insert are very general. The Krinsky
27 insert is similar to walking on a water bed. Despite this relatively low level of skill, Krinsky
28 never contemplated isolating certain portions of the foot, namely the toes. Krinsky never

1 contemplated addressing the needs of, for example, diabetics who need to stimulate their toes
2 to maintain circulation. The present invention also has a relatively low level of skill,
3 however, the skill applied is much higher than that of Krinsky. The present invention has
4 considered the actual formation and location of the bones in the foot. The present invention
5 has applied ergonomic principles in its application. The present invention has had clinical
6 studies performed and has made improvements based thereon. The level of skill between the
7 present invention and Krinsky is very different with different principles applied. Because of
8 the difference in the level of skill applied in the two inventions, Krinsky is incapable of
9 contemplating the needs and applications and claims of the present invention. With regard to
10 objective evidence in the present application of nonobviousness, in addition to the evidence
11 presented above, a review of the Appellant's drawings and see Figures 2, 6, 7, 8, 10, 16, and
12 17 compared to the Krinsky drawings in Figures 1 through 7 clearly illustrate the
13 nonobviousness of the present invention.

14 The Appellant respectfully submits that there is ample objective evidence of indicia of
15 nonobviousness in the present invention as compared to Krinsky and, therefore, the claims of
16 the present invention are not made obvious by Krinsky. The Appellant respectfully suggests
17 that claims 14 and 45 of the present invention are allowable and be admitted.

18 **5. General Arguments for Allowance of Claims 1-6, 8-14 and 32-37, 39-45**
19 **Being Rejected Under 35 U.S.C. § 103(a) as Being Unpatentable Over**
20 **Krinsky in view of Official Notice**

21 The rejection of the claims under 35 U.S.C. § 103(a) are reviewed as to their
22 obviousness or nonobviousness according to four indicia, which are: (1) determining the
23 scope and contents of the prior art; (2) ascertaining the differences between the prior art and
24 the claims at issue; (3) resolving the level of ordinary skill in the pertinent art; (4) considering
25 objective evidence present in the application indicating obviousness or nonobviousness.
26 These four factual inquiries are "indicia of obviousness or nonobviousness [that] may have
27 relevancy."

28 The Appellant incorporates by all previous discussions on this topic and will

1 specifically address the relevant case law to the claims in particular.

2 The scope and content of Krinsky is the teaching of a foot wearing item including a
3 deformable padding (cushion 10 is placed in the shoe and makes contact with the foot; see
4 col. 3, lines 25-27) comprising a flexible and deformable material (flowable, highly viscous
5 material 34). The differences between Krinsky and the present invention are numerous. The
6 cushion in Krinsky is placed underneath all areas of the foot including the toes and metatarso-
7 phalangeal joint (see figure 3) and therefore will permit the toes to curl downward when
8 walking. Some of the Krinsky claims only require the toes to flex or bend; such claims as 1,
9 4, 32, 35 which is extremely broad with that aspect. Krinsky teaches the deformable padding
10 placed in a shoe but doesn't teach that aspect of the shoe. The examiner takes official notice
11 that it is old and conventional in the art to have a shoe which includes an outsole, a midsole
12 and an insole, and states, therefore, it would be obvious to place the deformable padding
13 (cushion 10) of Krinsky in a shoe having an insole, a midsole, and an outsole. The cushion is
14 placed on top of the insole and therefore is aligned with the insole." The Appellant
15 respectfully disagrees with the Examiner and respectfully suggests that the Examiner has
16 misunderstood and misapplied the Krinsky design. As stated above, while Krinsky does teach
17 a foot wearing item that makes contact with entirety of the bottom of the foot, the gel area is
18 also under the entirety of the foot and under the pressure of the weight of the entire body.
19 While the gel is a flowable, highly viscous material, the gel is under the pressure of the entire
20 body and cannot therefore be grippable, or graspable by the toes alone as the pressure will
21 prevent localized movement under the pads of the toes. Thus, it is abundantly clear that the
22 Krinsky design is completely and totally different from the present invention. The difference
23 in the level of ordinary skill between Krinsky and the present invention are, as discussed
24 above, both relatively low level, but distinctly different. Additional objective evidence of
25 nonobviousness of the present invention and Krinsky can be found as discussed above and in
26 Figures 2, 6, 7, 8, 10, 16, and 17 of the present invention compared to the Krinsky drawings
27 in Figures 1 through 7.

28 The Appellant respectfully submits that there is ample objective evidence of indicia of

1 nonobviousness in the present invention as compared to Krinsky and, therefore, the claims of
2 the present invention are not made obvious by Krinsky. The Appellant respectfully suggests
3 that Claims 1-6, 8-14 and 32-37, 39-45 of the present invention are allowable and be
4 admitted.

5
6 **6. General Arguments for Allowance of Claims 1 and 32 Being Rejected**
7 **Under 35 U.S.C. § 103(a) as Being Unpatentable Over Kawashima in view**
8 **of US 4,768,295 (Ito)**

9 The standard for review under 35 U.S.C. § 103(a) as to their obviousness or
10 nonobviousness is according to four indicia, which are: (1) determining the scope and
11 contents of the prior art; (2) ascertaining the differences between the prior art and the claims
12 at issue; (3) resolving the level of ordinary skill in the pertinent art; (4) considering objective
13 evidence present in the application indicating obviousness or nonobviousness. These four
14 factual inquiries are “indicia of obviousness or nonobviousness [that] may have relevancy.”

15 However, when a claim is being rejected due to a combination of patents, additional
16 rules apply. Numerous court decisions emphasize that a combination of reference teachings
17 is improper unless the prior art suggests such a combination. See In re Bond, 910 F.2d 831,
18 15 USPQ2d 1566 (Fed. Cir. 1990) (the PTO erred in rejecting the claimed invention as an
19 obvious combination of the teachings of two prior art references when the prior art provided
20 no teaching, suggestion or incentive supporting the combination); SmithKline Diagnostics,
21 Inc. v. Helena Laboratories Corp., 859 F.2d 878, 887, 8 USPQ2d 1468, 1475 (Fed. Cir. 1988)
22 (a challenger to the validity of a patent “cannot pick and choose among the individual
23 elements of assorted prior art references to recreate the claimed invention,”; the challenger
24 “has the burden to show some teaching or suggestion in the references to support their use in
25 the particular claimed combination.”); Elf Atochem North America, Inc. v. LaRoche
26 Industries, Inc., 85 F. Supp.2d 336, 343 (D. Eel. 2000) (“Two or more prior art references
27 may be combined to demonstrate obviousness, but the prior art must provide a suggestion or
28 motivation to combine the references.”).

1 Here, the Examiner cites two prior art, Kawashima and United States Patent 4,768,295
2 issued to Ito on September 6, 1988 (hereafter "Ito") suggesting that the two in combination
3 make obvious the present invention. The Appellant incorporates all previous discussions
4 regarding Kawashima. The Appellant respectfully submits that none of the prior art cited by
5 the Examiner suggest a combination with each other, that none of the prior art teach, suggest
6 or provide incentive for the combination offered by the Examiner, and that there is no
7 teaching or suggestion in the cited references to support the particular claimed combination.
8 The Appellant further submits that the combination of Kawashima and Ito does not meet the
9 four indicia to show that the present invention is obvious in light of the two cited prior art.

10 The Examiner states that Kawashima teaches a footwear item as claimed (see the 102
11 rejection above for details) except for the deformable material being a gel. Ito teaches a
12 cushioning member placed in a cavity of the sole filled with a gel. The Examiner states that It
13 would have been obvious to one of ordinary skill in the art to form the cushioning members of
14 Kawashima to be a gel filled cushioning member, as taught by Ito, to facilitate absorbing the
15 shock instantly. The Appellant respectfully disagrees with the Examiner and respectfully
16 suggests that the Examiner has misapplied both Kawashima and Ito, and that neither
17 Kawashima nor Ito has anything whatsoever to do with the present invention.

18 The design taught by Ito is completely and totally different from the present invention.
19 An examination of Figures 1-6 alone illustrate a device that is completely and totally different
20 from the present invention. An examination of Ito shows it to be a utility patent teaching a
21 shock absorbing insole comprised of membranes and chambers for the purpose of providing
22 both cushioning and lateral support of the foot and is specifically designed for sports shoes. It
23 is abundantly clear that what Ito had in mind was to take a shoe sole and adapt it so that it
24 provides a cushioning support pad for two areas of the foot and so that the entire assembly
25 provides a special shock absorber with the special property of providing a repulsion force
26 when kicking. (See abstract, et. al.). It is clear from just an examination of the figures of the
27 present invention alone, that the present invention is completely different from Ito. The shoe
28 sole of the present invention does not provide cushioning for two areas of the foot, but instead

1 is under one section of the foot, specifically the toes; the portion under the toes is not for
2 cushion or for support or for repulsion force, but instead is for tactile sensory stimulation of
3 the toes; the toe support of the present invention does not provide a repulsion force when
4 kicking, but instead disperses the load forces by the toes during the grasping-gripping motion
5 of the toes during walking.

6 In addition, referring to Figures 2, 4, 5, and 6, the Ito design illustrates the cushion to
7 be comprised of channels, grooves, or a plurality of chambers. The Ito design requires the
8 two support pads to provide a repulsion force. It is abundantly clear that what Ito intended
9 was to have the structural cushioning elements of the shoe designed in such a manner as to
10 also provide, not just support for the shoe, but also to perform a "double duty" by creating a
11 repulsion force, as discussed above. An examination of Figures 9 and 10 of the present
12 invention shows very clearly that the toe cushion of the toe cushion does not have any
13 channels, grooves, or a plurality of chambers, but is instead one open, internally unimpeded
14 cell. Further, Ito describes the cushioning elements to be located under the balls of the toes,
15 whereas, as discussed above, the present invention requires the toe cushion to reside in the
16 area from the base of the toes to the tips of the toes. Therefore, it is abundantly clear that the
17 cushioning elements of the Ito design is composed of a totally different material and serves a
18 totally different purpose.

19 As discussed above, Kawashima is completely different from the present invention.
20 Further, as discussed above in detail, Kawashima does not reside in an area comprising the
21 base of the toes to the tips of the toes so as to provide tactile stimulation to the pads of the
22 toes, but instead Kawashima provides cushioning to the balls of the feet. Therefore, and as
23 discussed above, Kawashima is completely and totally different from the present invention.
24 Further, as discussed above, Ito has nothing whatsoever to do with the present invention and
25 does not add anything to Kawashima in relation to the present invention.

26 It is clear that the scope and contents of Ito and Kawashima lie outside that of the
27 present invention, that significant differences exist between the present invention and the
28 cited prior art, that the level of ordinary skill in the art in both cited prior art is low enough

1 that had either of them contemplated the claims of the present invention, those claims could
2 have easily been encompassed by either or both but those prior art did not contemplate or
3 include such claims, and that there is voluminous objective differences between the present
4 invention and the two cited prior art. The Appellant respectfully submits that there is ample
5 objective evidence of indicia of nonobviousness in the present invention as compared to Ito
6 and Kawashima and, therefore, the claims of the present invention are not made obvious by
7 Ito and Kawashima. Additionally, the Appellant submits that Ito and Kawashima is an
8 improper combination and that there is no evidence that either contemplates a combination
9 with the other. The Appellant respectfully suggests that Claims 1-6, 8-14 and 32-37, 39-45 of
10 the present invention are allowable and be admitted.

11
12 **7. General Arguments for Allowance of Claims 5 and 36 Being Rejected**
13 **Under 35 U.S.C. § 103(a) as Being Unpatentable Over Kawashima**
14

15 The standard for review under 35 U.S.C. § 103(a) as to their obviousness or
16 nonobviousness is according to four indicia, which are: (1) determining the scope and
17 contents of the prior art; (2) ascertaining the differences between the prior art and the claims
18 at issue; (3) resolving the level of ordinary skill in the pertinent art; (4) considering objective
19 evidence present in the application indicating obviousness or nonobviousness. These four
20 factual inquiries are "indicia of obviousness or nonobviousness [that] may have relevancy."
21

22 The Appellant incorporates all previous discussions regarding the Kawashima
23 reference.
24

25 The contents and scope and differences of Kawashima with regard to these specific
26 claims, is that the Kawashima design is of a very thin depth. As shown in Figures 4 and 5 of
27 the Kawashima design, the depth of thickness under the toes is significantly less than 6 mm.
28 As discussed above, the Kawashima patent resides not in the insole of the shoe, but lies above

1 and upon the insole of the shoe, upon which the foot resides, both of which are inside the shoe
2 and must fit between the insole of the shoe and the top of the shoe. In such a situation, it is
3 impossible to have a cushion of at least 6 mm, as well as the entire foot or even just the toes
4 inside the interior of a shoe. It is abundantly clear that the Kawashima design is totally and
5 completely different from the present invention, has a different scope and content from the
6 present invention, and, further, that it is impractical and impossible to apply Kawashima in
7 relation to these claims and the present invention as a whole.

8 The Appellant respectfully submits that there is ample objective evidence of indicia of
9 nonobviousness in the present invention as compared to Kawashima and, therefore, the claims
10 of the present invention are not made obvious by Kawashima. The Appellant respectfully
11 suggests that Claims 5 and 36 of the present invention are allowable and be admitted.

12
13 **8. General Arguments for Allowance of Claims 2, 33 and 8, 13, 39, and 44**
14 **Being Rejected Under 35 U.S.C. § 103(a) as Being Unpatentable Over**
15 **Kawashima in view of US 5,775,005 (McClelland)**
16

17 The standard for review under 35 U.S.C. § 103(a) as to their obviousness or
18 nonobviousness is according to four indicia, which are: (1) determining the scope and
19 contents of the prior art; (2) ascertaining the differences between the prior art and the claims
20 at issue; (3) resolving the level of ordinary skill in the pertinent art; (4) considering objective
21 evidence present in the application indicating obviousness or nonobviousness. These four
22 factual inquiries are "indicia of obviousness or nonobviousness [that] may have relevancy."

23 However, when a claim is being rejected due to a combination of patents, additional
24 rules apply. Numerous court decisions emphasize that a combination of reference teachings
25 is improper unless the prior art suggests such a combination. See In re Bond, 910 F.2d 831,
26 15 USPQ2d1566 (Fed. Cir. 1990) (the PTO erred in rejecting the claimed invention as an
27 obvious combination of the teachings of two prior art references when the prior art provided
28 no teaching, suggestion or incentive supporting the combination); SmithKline Diagnostics,

1 Inc. v. Helena Laboratories Corp., 859 F.2d 878, 887, 8 USPQ2d 1468, 1475 (Fed. Cir. 1988)
2 (a challenger to the validity of a patent “cannot pick and choose among the individual
3 elements of assorted prior art references to recreate the claimed invention,”; the challenger
4 “has the burden to show some teaching or suggestion in the references to support their use in
5 the particular claimed combination.”); Elf Atochem North America, Inc. v. LaRoche
6 Industries, Inc., 85 F. Supp.2d 336, 343 (D. Eel. 2000) (“Two or more prior art references
7 may be combined to demonstrate obviousness, but the prior art must provide a suggestion or
8 motivation to combine the references.”).

9 Here, the Examiner refers to all prior cited art and United States Patent 5,775,005
10 issued to McClelland on July 7, 1998 (hereafter “McClelland”) suggesting that all the prior
11 cited art in combination with McClelland make obvious the present invention. The Appellant
12 incorporates all previous discussions regarding all the prior cited art. The Appellant
13 respectfully submits that none of the prior art cited by the Examiner suggest a combination
14 with each other, that none of the prior art teach, suggest or provide incentive for the
15 combination offered by the Examiner, and that there is no teaching or suggestion in the cited
16 references to support the particular claimed combination. The Appellant further submits that
17 the combination of all the cited prior art does not meet the four indicia to show that the
18 present invention is obvious in light of the two cited prior art.

19 The scope and contents of McClelland shows it to be a utility patent teaching an
20 outsole assembly, a pair of cleated windows that extend to the outsole and a pair of
21 cushioning inserts and is specifically designed for boots.

22 The differences between McClelland and the present invention are numerous. It is
23 abundantly clear that what McClelland has in mind was to take a boot sole and adapt it so that
24 provides a cushioning support pad for two areas of the foot and so that the entire assembly
25 provides two, special, double-layer cushioning elements that also provide the structural
26 support for the shoe as well as the outsole for the shoe. It is clear from just an examination of
27 the drawings alone that the present invention is completely different from McClelland. The
28 shoe sole of the present invention does not provide cushioning for two areas fo the foot, but

1 instead is under one section of the foot, specifically the toes; the portion under the toes is not
2 for cushioning or support, but instead is for tactile sensory stimulation of the toes; the toe
3 support of the present invention does not provide completion of the outsole, but instead lies
4 within the insole and midsole for the purposes of facilitating the grasping-gripping motion of
5 the toes during walking.

6 In addition, referring also to Figure 3, the McClelland design illustrates the cushion to
7 be comprised of grooves or cleats that become the supporting structural element of the shoe
8 and its outsole. The McClelland design requires the two support pads, which are comprised
9 of two layers of cleated pads to be load bearing, structural elements of the shoe and to also
10 function as the outsole of the shoe. It is abundantly clear that what McClelland intended was
11 to have the structural elements of the shoe designed in such a manner as to also provide, not
12 just support for the shoe, but also to perform a "double duty" by creating a special padding
13 under the balls of the foot and the heel. An examination of Figures 9 and 10 of the present
14 invention show very clearly that the toe cushion does not have any grooves or cleats, but is
15 instead one smooth crescent shaped cell; the toe cushion is not a supporting structural element
16 of the shoe or an outsole, but instead, rests upon the structural support of the shoe. Therefore,
17 it is abundantly clear that the cushioning elements of the McClelland is composed of a totally
18 different material and serves a totally different purpose.

19 Additionally, referring to Figures 1-5, the McClelland design illustrates the cushioning
20 elements to be viewed from the exterior of the shoe. The McClelland design requires that the
21 cushioning elements each have a surface exposed to the exterior, open air, walking surfaces,
22 and also have an aesthetic quality. It is abundantly clear that the McClelland design requires
23 the cushioning elements to be of such a nature and appearance that they enhance the exterior
24 appearance and augment the sporty image of the shoe. Further, because the outsole of the
25 cushioning elements are exposed, the outer cosign of the cushions require that they be
26 constructed of a material that can't withstand the elements, as well as the wear and tear that
27 the exterior of a sport shoe or boot must experience. An examination of Figures 8 and 9 of
28 the present invention shows very clearly that the cushioning element of the present invention

1 is completely within the interior portion of the shoe, having no portion, outsole or otherwise,
2 exposed to the exterior of the shoe. Additionally, because the toe cushion is out of sight,
3 exclusively in the interior fo the shoe, the cushion does not and cannot augment the exterior
4 appearance of the shoe, neither to augment the sportiness fo the shoe or for any other quality.
5 Further the outer casing of the toe cushion is not designed of a thick, tough material that can
6 withstand the environment and provide structural support for the shoe, but instead is made of
7 a soft, malleable material that can be manipulated by the toes and that also has a sensory
8 enhancing quality. Therefore, it is abundantly clear that the cushioning elements fo the
9 McClelland design is designed for a completely different purpose and composed of a totally
10 different material.

11 In addition, referring to the abstract, the McClelland design teaches the cushioning
12 element that extends to the outer edges of the sole of the shoe have substantially transparent
13 walls, whereby the other elements of the shoe can be viewed. It is clear that what McClelland
14 intended is to have a shoe that has a cushioning element that extends beyond the area under
15 the foot in areas where it is impossible to cushion the foot, so much so that the cushion can be
16 seen and can be used from the outside of the shoe. In addition, McClelland intends for that
17 part of the cushion to be seen from the outside of the sole of the shoe be transparent to add
18 novelty and interest to the exterior of the shoe. It is clear from an examination of Figures 1,
19 3, 8, 9, 10, 11, 12, 15, 17, 18, 19, and 20, that the present invention does not extend to the
20 outer periphery of the shoe. It is also clear that the cushioning element of the present
21 invention cannot be seen from the exterior of the shoe. Additionally, it is clear that the
22 cushioning element of the present invention is not transparent, has no need to be transparent,
23 and is not claiming to be transparent. It is further clear that the cushioning element fo the
24 present invention does not, in any manner whatsoever, add any novelty or any interest to the
25 exterior of the shoe. Therefore, it is clear that he cushioning element of the McClelland shoe
26 is entirely different form the cushioning element of the present invention.

27 Referring to Figures 1-5, the McClelland patent teaches that the cushion is part of the
28 outsole of the shoe. The McClelland requires that the cushioning elements be a structural

1 support of the sole of the shoe and of such a material that can bear the weight of the foot and
2 body of the wearer. It is clear that what McClelland intended is to have a shoe sole that is
3 comprised of several layers, which contains separate pieces that do not touch each other and
4 act like foundation supports on which the foot resides and with the layer surrounding this
5 foundation filling in the void between the two cushioning elements filling from the interior
6 and extending outwardly to the periphery of the sole. It is clear from an examination of
7 Figures 8, 9, 10 and 12, that the present invention does not place the cushioning element in
8 the outsole of the shoe, but instead places it in the insole of the shoe. The present invention
9 does not use the cushioning element as a structural support, but instead, uses the cushioning
10 element merely as an additive element to the insole. The present invention is not designed to
11 bear the weight of the foot and body of the wearer, but instead, is merely a stimulus for toes
12 and to allow the toes to perform the grasping-gripping action. The present invention is not
13 comprised of four pieces, but instead is a single crescent shaped piece. The present invention
14 is not a foundation device for the shoe, but instead, is a single piece to stimulate the tactile
15 sense of the under toe and to allow the toe to grasp and grip within the shoe. Therefore, it is
16 abundantly clear that the McClelland device is completely different from and has nothing to do
17 with the present invention.

18 Referring to Figure 4, the McClelland patent teaches that the cushioning element is in
19 addition to and underneath a foam material that "covers the inserts and provides additional
20 cushioning" (Col. 3, line 67 through Col. 4, line 1). The McClelland design requires that a
21 second cushion be placed over its cushion elements. It is clear from an examination of
22 Figures 6, 8, 10, and 12, that the present invention does not have a foam material that covers
23 the upper surfaces of the cushioning elements. In addition, the present invention does not
24 have a layer above the cushioning element, but instead, the cushioning element is the upper
25 layer, or at least one portion of the upper layer. Therefore, it is abundantly clear that the
26 cushioning element of the McClelland shoe is entirely different from the cushioning element
27 of the present invention.

28 Furthermore, the level of skill of McClelland is among the same level of skill as the

1 other prior cited art. Had the claims of the present invention been obvious to McClelland,
2 clearly, those claims would have been incorporated into McClelland and the prior cited art;
3 yet the claims of the present invention are not present in any of the prior cited art.

4 Additionally, there is no evidence in McClelland that it would contemplate a
5 combination with any of the prior art cited by the Examiner.

6 It is clear that the scope and contents of McClelland lie outside that of the present
7 invention, that significant differences exist between the present invention and the cited prior
8 art, that the level of ordinary skill in the art in both cited prior art is low enough that had
9 either of them contemplated the claims of the present invention, those claims could have
10 easily been encompassed by either or both but those prior art did not contemplate or include
11 such claims, and that there is voluminous objective differences between the present invention
12 and the two cited prior art. The Appellant respectfully submits that there is ample objective
13 evidence of indicia of nonobviousness in the present invention as compared to McClelland
14 and, therefore, the claims of the present invention are not made obvious by McClelland .
15 Additionally, the Appellant submits that McClelland and the prior cited art is an improper
16 combination and that there is no evidence that any contemplates a combination with the other.
17 The Appellant respectfully suggests that Claims 2, 33 and 8, 13, 39, 44 of the present
18 invention are allowable and be admitted.

19 **9. General Arguments for Allowance of Claims 3, 34 and 9, 14, 40, and 45**
20 **Being Rejected Under 35 U.S.C. § 103(a) as Being Unpatentable Over the**
21 **References and in view of Official Notice**

22
23 The standard for review under 35 U.S.C. § 103(a) as to their obviousness or
24 nonobviousness is according to four indicia, which are: (1) determining the scope and
25 contents of the prior art; (2) ascertaining the differences between the prior art and the claims
26 at issue; (3) resolving the level of ordinary skill in the pertinent art; (4) considering objective
27 evidence present in the application indicating obviousness or nonobviousness. These four
28 factual inquiries are "indicia of obviousness or nonobviousness [that] may have relevancy."

1 The Appellant herein incorporates all previous discussions of all previous cited prior
2 art. Specifically with regard to Claims 3, 34 and 9, 14, 40, and 45, the Appellant respectfully
3 submits that these claims are outside the contents and scope of all prior cited art. The
4 differences between the prior cited art and the present claims are numerous. As discussed in
5 full above, the above references are totally and completely different from the present
6 invention and have nothing whatsoever to do with the present invention. The present
7 invention is a particular device for tactile stimulation of the pads of the toes during the
8 grasping-gripping motion that occurs during walking. The Appellant respectfully suggests
9 that the Examiner has misapplied the previous references. While the present invention does
10 lie within a shoe, it is essentially and primarily a means to provide tactile stimulation to the
11 toes and a physical means to recreate the grasping-gripping motion of the toes. The Appellant
12 respectfully suggests that it is not old or conventional to have tactile stimulants treated with a
13 fungicide. It is abundantly clear that the previous references are completely different from the
14 present invention and do not apply. Further objective evidence can be seen in the figures of
15 the present invention as compared to that of all the cited prior art.

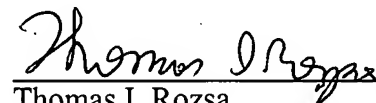
16 It is clear that the scope and contents of all the cited prior art lie outside that of the
17 present invention, that significant differences exist between the present invention and all the
18 cited prior art, that the level of ordinary skill in the art in all the cited prior art is low enough
19 that had any of them contemplated the claims of the present invention, those claims could
20 have easily been encompassed by any of the prior art but the claims of the present invention
21 was not contemplated or included in the prior art, and that there is voluminous objective
22 differences between the present invention and the cited prior art. The Appellant respectfully
23 submits that there is ample objective evidence of indicia of nonobviousness in the present
24 invention as compared to all the prior cited art, and, therefore, the claims of the present
25 invention are not made obvious by any of the cited prior art. Additionally, the Appellant
26 submits that the cited prior is an improper combination and that there is no evidence that any
27 prior art contemplates a combination with the other. The Appellant respectfully suggests that
28 Claims 3, 34 and 9, 14, 40, and 45 of the present invention are allowable and be admitted.

10. Conclusion

Therefore, it is respectfully submitted that for all of the above extensive arguments, all pending claims of invention Claims 1-14 and 32-45 are allowable. All of the extensive arguments set forth in this argument section have clearly overcome the Examiner's rejection. Accordingly, the Patent Office Board of Appeals is respectfully requested to reverse the Patent Examiner Kavanaugh and to order an allowance of Claims 1-14 and 32-45.

Respectfully submitted,

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Thomas I. Rozsa
Registration No. 29,210
ROZSA LAW GROUP LC
18757 Burbank Boulevard, Suite 220
Tarzana, California 91356-3346

Customer No. 021907
Telephone (818) 783-0990
Facsimile (818) 783-0992

VIII. CLAIMS APPENDIX - 37 C.F.R. SECTION 41.37(c)(1)(viii)

The claims of invention under appeal are set forth in detail in this appendix:

1. A shoe having a shoe sole including an outsole, a midsole, an insole and having a front area over which the toes of a foot rest when the shoe is worn, the improvement comprising:
 - c. a non-leaking deformable gel formed within the front area of the sole and aligned with the insole so that the gel is located beneath the toes of the foot when the shoe is worn, so that all five toes rest on the gel and the base of the big toe right below the 1st metatarso-phalangeal joint also rests on the gel;
 - d. whereby the non-leaking deformable gel permits the toes to curl, flex, bend or grasp downward when a wearer of the shoe is walking.
2. The invention in accordance with Claim 1, wherein said gel is covered with a stretch material.
3. The invention in accordance with Claim 1, wherein said gel is treated with a fungicide.
4. A shoe having a shoe sole including an outsole, a midsole, an insole and having a front area over which the toes of a foot rest when the shoe is worn, the improvement comprising:
 - a. a deformable padding formed within the front area of the sole and aligned with the insole so that the deformable padding is located beneath the toes of the foot when the shoe is worn, so that all five toes rest on the deformable padding and the base of the big toe rests right below the 1st metatarso-phalangeal joint and also rests on the deformable padding; and
 - b. the deformable padding is selected from the group consisting of a deformable

10 liquid gel pack, a deformable liquid, a gel pack encased in a stretch Lycra®
fabric, silicone, foam, memory foam, soft memory type flexible material, soft
rubber, soft synthetic plastic, polyurethane gel, neoprene, polyvinyl,
polyethylene or polyurethane;

15 c. whereby, the deformable padding permits the toes to curl, flex, bend or grasp
downward when a wearer of the shoe is walking.

5. The invention in accordance with Claim 4, wherein said deformable padding is at least
6mm in depth.

6. The invention in accordance with Claim 4, wherein said deformable padding is also
aligned with a portion of the midsole in addition to being aligned with the insole.

7. The invention in accordance with Claim 4, further comprising a cavity formed into the
front portion of the shoe to receive the deformable padding.

8. The invention in accordance with Claim 4, wherein said deformable padding is
covered with a stretch material.

9. The invention in accordance with Claim 4, wherein said deformable padding is
treated with a fungicide.

10. A foot wearing item to be worn on a foot, the foot wearing item including an insole
against which the foot rests and having a front area over which the toes of the foot rest
when the foot wearing item is worn, the improvement comprising:

5 a. a flexible and deformable material formed within the front area of the foot
wearing item and aligned with the insole so that the flexible material is located
beneath the toes of the foot when the foot wearing item is worn so that all five

toes rest on the flexible material and the base of the big toe right below the 1st metatarso-phalangeal joint also rests on the flexible material;

- b. whereby the flexible material permits the toes to curl downward when a wearer of the wearing apparel is walking.

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11. The invention in accordance with Claim 10, wherein the flexible material is selected from the group consisting of non-leaking semi-solid gel filled padding, silicone, foam, memory foam, soft rubber, soft synthetic plastic, a gel pack encased in a stretch Lycra® fabric, polyurethane gel, neoprene, polyvinyl, polyethylene or polyurethane.
12. The invention in accordance with Claim 10, wherein the foot wearing item is selected from the group consisting of shoes, sandals, flip-flops or athletic shoes.
13. The invention in accordance with Claim 10, wherein said flexible and deformable material is covered with a covering material.
14. The invention in accordance with Claim 10, wherein said flexible and deformable material is treated with a fungicide.
32. A shoe having a shoe sole including an outsole, a midsole, an insole and having a front area over which the toes of a foot rest when the shoe is worn, the improvement comprising:
- c. a non-leaking deformable gel formed within the front area of the sole and aligned with the insole so that the gel is located beneath the toes of the foot when the shoe is worn, so that all five toes rest on the gel;
- d. whereby the non-leaking deformable gel permits the toes to curl, flex, bend or grasp downward when a wearer of the shoe is walking.

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33. The invention in accordance with Claim 32, wherein said gel is covered with a stretch material.
34. The invention in accordance with Claim 32, wherein said gel is treated with a fungicide.
35. A shoe having a shoe sole including an outsole, a midsole, an insole and having a front area over which the toes of a foot rest when the shoe is worn, the improvement comprising:
- a. a deformable padding formed within the front area of the sole and aligned with the insole so that the deformable padding is located beneath the toes of the foot when the shoe is worn, so that all five toes rest on the deformable padding; and
 - b. the deformable padding is selected from the group consisting of a deformable liquid gel pack, a deformable liquid, a gel pack encased in a stretch Lycra® fabric, silicone, foam, memory foam, soft memory type flexible material, soft rubber, soft synthetic plastic, polyurethane gel, neoprene, polyvinyl, polyethylene or polyurethane;
 - c. whereby, the deformable padding permits the toes to curl, flex, bend or grasp downward when a wearer of the shoe is walking.
36. The invention in accordance with Claim 35, wherein said deformable padding is at least 6mm in depth.
37. The invention in accordance with Claim 35, wherein said deformable padding is also aligned with a portion of the midsole in addition to being aligned with the insole.

38. The invention in accordance with Claim 35, further comprising a cavity formed into the front portion of the shoe to receive the deformable padding.
39. The invention in accordance with Claim 35, wherein said deformable padding is covered with a stretch material.
40. The invention in accordance with Claim 35, wherein said deformable padding is treated with a fungicide.
41. A foot wearing item to be worn on a foot, the foot wearing item including an insole against which the foot rests and having a front area over which the toes of the foot rest when the foot wearing item is worn, the improvement comprising:
- a. a flexible and deformable material formed within the front area of the foot wearing item and aligned with the insole so that the flexible material is located beneath the toes of the foot when the foot wearing item is worn so that all five toes rest on the flexible material;
 - b. whereby the flexible material permits the toes to curl downward when a wearer of the wearing apparel is walking.
42. The invention in accordance with Claim 41, wherein the flexible material is selected from the group consisting of non-leaking semi-solid gel filled padding, silicone, foam, memory foam, soft rubber, soft synthetic plastic, a gel pack encased in a stretch Lycra® fabric, polyurethane gel, neoprene, polyvinyl, polyethylene or polyurethane.
43. The invention in accordance with Claim 41, wherein the foot wearing item is selected from the group consisting of shoes, sandals, flip-flops or athletic shoes.

44. The invention in accordance with Claim 41, wherein said flexible and deformable material is covered with a covering material.
45. The invention in accordance with Claim 41, wherein said flexible and deformable material is treated with a fungicide.

1 **IX. EVIDENCE APPENDIX - 37 C.F.R. 41.37(c)(1)(ix)**

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3 There was no extra evidence relied upon by the Examiner or the Appellants.
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X. RELATED PROCEEDINGS APPENDIX - 37 C.F.R. 41.37(c)(1)(x)

There are no such decisions rendered by the Board of Appeals in any proceeding.

APPEAL.SHOE.002